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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/546,002	08/18/2005	Masaya Naoi	276756US2PCT	8654
22850	7590	12/19/2007		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ABRAMS, NEIL	
			ART UNIT 2839	PAPER NUMBER
			NOTIFICATION DATE 12/19/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No.

10/546,002

Applicant(s)

NAOI, MASAYA

Examiner

Neil Abrams

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11-28-2007
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Drawing amendment, figure 4, objected to, the T1, T2 symbols should be applied as thickness indicators as in Maoi figure 8, at G and applied to figure 17 which shows different thickness. Correction required in next response

1. Claims 1, 2, 4-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims, see claim 1, line 10, call for "flat surface contacting a subject to be inspected" other side having projected parts.

However no basis for this limitation is found in disclosure as filled and it is considered as "new matter". Only figure 17 is seen to show <sup>a film with</sup> flat side/projection sides ~~of a film~~; however <sup>in</sup> no disclosure of the recited use is found. If present it shows be pointed out the response by page, line and figure numbers. Note that limitations recited in claims must be shown in drawings

2. Claims 1, 2, 4-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1, 2, the "at least 0.9" terms are unclear, in that they cover a range in which insulating parts project, but the claims call for conductive parts to project. The terms could be changed to - - greater than 1.0- - .

4. Claims 1, 2, 4-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kokubo in view of Naoi 442.

5. For claims 1, 2, Kokubo coassigned with this application, see figures 4, 11, 12, 13, is seen to "admittedly" disclose all features recited in the claims, see frame plate 10, films 20, etc as well as the T2/T1 at least 0.9 feature .. but to lack the ---one surface flat other surface having projections---- feature. The Naoi 42, film fig 8 includes a "flat side/projection side" feature and also appears to meet the --T2/T1 at least 0.9--- limitation. It would have been obvious to replace the Kokubo film with ones like that of Naoi, this type seeming to be easier to manufacture. Also note that the T2/T1 even if not clearly disclosed is seen as a matter of obvious design and does not appear to be at issue.

6. Dependent claim features also met by Kokubo or to be obvious variations of that device. As examples for claims 6, 8 note Kokubo figure 13 pcb 30 and insulating sheet 40. For claim 4, lines 4-7, note wafer 6 to be tested. Also claim 4, S1/S2 ratios and claim 5 coefficient deemed obvious matter of design to choice optimum performance .

7. For claims 1, 2, 4, 5 also note that only the anisotropic connector is being claimed and therefore its manner of use, i.e. ---flat surface to contact object inspected--- cannot be relied upon to overcome the rejection. For claims 6-14, which seem to call for a circuit board to be contacted by the ~~rejection~~ <sup>projection</sup> side, it is deemed an obvious variation to select one or the other side <sup>of film</sup> to contact the pcb, no new result obtained by such choice. For example to form Naoi fig 9 assembly with film 42 flat side up to


engage chip 21 is seen as a obvious variation producing no substantial advantage over Naoi teachings.

8. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive. Arguments are only directed to the-- film flat side contacts subject to be inspected--- feature and these have been responded to above. Also note the new matter rejection directed to the feature at issue.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Neil Abrams at telephone number 571-272-2089

  
NEIL ABRAMS  
PRIMARY EXAMINER